

REMARKS

35 USC 112

Claims 18-23, 25-27, 30-36, 41-49 and 51-56 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicant respectfully disagrees.

First, it is not clear that the “comprising” language in claims 18, 36, and 42 is contrary to the “consisting of” language in the preambles of each claim primarily because the “consisting of” language is defining the three components or the specific method steps. There are no additional elements or method steps added outside of those claims. The only thing that the “comprising” language defines is the subset of the solvent system or the structural constituent. However, in an effort to expedite this application, the “comprising” language is removed from claims 18, 36 and 42.

Claims 43-46 are canceled from this application, thus mooted the Examiner’s second rejection.

The phrases “hydrocarbon surfactant” and “fluorocarbon surfactant” are amended in the claims to reflect the phrases used in paragraph [0042] of the application.

Claim 42 is amended herein to clarify the solvent system.

35 USC §103

Claims 18-22, 24-25, 36, 41-49 and 51-52 are rejected under 35 USC 103(a) as obvious over FR 281602 in view of Hattori (US 6165676) and Miyamoto et al. (US US 6808857).

Claims 18-21, 24-25, 36, 41-49 and 51-52 are rejected under 35 USC 103(a) as obvious over FR 281602 in view of Drage (US 5858547) and Miyamoto et al. (US US 6808857).

The Applicant respectfully disagrees with all of these rejections.

First, the Examiner does not reject claims 26-27, 30-35 and 53-56 in the current Office Action. The Applicant respectfully requests that the Examiner reissue the Office Action stating that those claims are allowable.

The independent claims include the phrase "consisting of". MPEP Section 2111.03 states:

"The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith.")"

Claim 18 recites: " A planarization composition, consisting of: an o-cresol-based polymer compound and a resol phenolic resin; at least one surfactant; and a solvent system."

Claim 36 contains similar provisions as the ones in Claim 18.

The primary reference in these rejections is the FR 2801602. These components in FR 2801602 consist of catalysts based on sulfonic acid. The Examiner appears to be reading the abstract to state that the product in FR 2801602 comprises either a phenolic resin or a catalyst – but that is an incorrect reading. It says that the additives may be added to either of the resin or the catalyst – but the catalyst is absolutely required and necessary. The contemplated compositions of the present application do not contain catalysts based on sulfonic acid, and therefore, the claims have been amended to reflect that. The FR reference does not disclose compounds without catalysts based on sulfonic acid, and the remaining references are no longer relevant, and therefore, the current claims are allowable over the above-mentioned references.

The current amendments are made in this case to expedite prosecution of this application and should not be considered an admission by the applicant that other claims cannot be considered novel and non-obvious over this art. The Applicants plan to file a divisional application and potentially a continuation application in order to address other patentable embodiments; however, in order to focus this matter and move this case to allowance, the claims are amended to include “consisting of” language. The Applicant does not need to speculate on the inclusion of other components, such as catalysts based on sulfonic acid compounds, especially since they are outside the scope of the claims and they are absorbing materials, which is again, outside the scope of this application.

CONCLUSION

The undersigned Attorney-of-Record respectfully requests an interview to resolve any remaining issues the Examiner has after review of this response, in order to avoid additional and lengthy written prosecution. Dr. Thompson is available during the week from 8AM to 4PM PST and can be reached at 949-224-6282.

REQUEST FOR ALLOWANCE

Claims 18-22, 24-27, 30-36, 41-42, 47-49 and 51-56 and 77-78 are pending in this application, and the Applicant respectfully requests that the Examiner reconsider the claims in light of the arguments presented and allow all pending claims.

Respectfully submitted,

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